



UNITED STATES PATENT AND TRADEMARK OFFICE

ck
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,740	09/12/2003	Robert E. Ferrell	28967/35255B	9487

4743 7590 01/23/2006

MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606

EXAMINER

BERTOGLIO, VALARIE E

ART UNIT PAPER NUMBER

1632

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/661,740	FERRELL ET AL.	
	Examiner	Art Unit	
	Valarie Bertoglio	1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,13 and 22-51 is/are pending in the application.
- 4a) Of the above claim(s) 22-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 12,13 and 37-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1632

DETAILED ACTION

The Group and/or Art Unit designation of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Examiner Valarie Bertoglio, Ph.D., Group Art Unit 1632.

Applicant's Election dated 12/23/2005 has been received. After further examination, the elected claims have been determined to require further restriction as set forth below.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

It is noted that the Groups named below are subject to further restrictions see section .

- I. Claim 12 and 37-51, drawn to a method of treatment for hereditary lymphedema using VEGF-C protein therapy, classified in class 514, subclass 2.
- II. Claim 12 and 37-46, drawn to a method of treatment for hereditary lymphedema using VEGF-D protein therapy, classified in class 514; subclass 2.
- III. Claim 12 and 37-51, drawn to a method of treatment for hereditary lymphedema using VEGF-C gene therapy, classified in class 514, subclass 44.
- IV. Claim 12 and 37-46, drawn to a method of treatment for hereditary lymphedema using VEGF-D gene therapy, classified in class 514, subclass 44.
- V. Claim 13, drawn to a method of ex vivo gene therapy, classified in class 424, subclasses 93.1.

Art Unit: 1632

The inventions are distinct, each from the other because of the following reasons:

Inventions I-IV are patentably distinct because they are drawn to distinct methods using different method steps and reagents. Inventions I and II are drawn to protein therapy. Protein therapy and gene therapy are distinct methods of treatment with vastly different technical considerations and use different treatment reagents. Inventions III and IV are drawn to gene therapy. Inventions I and III use a VEGF-C product for treatment whereas Inventions II and IV use a VEGF-D product for treatment. Inventions I and II are classified differently from Inventions III and IV. It would require undue burden to search any of Inventions I-IV together.

Inventions I-IV are patentably distinct from Invention V because they are drawn to distinct methods using different reagents, different method steps and different technical considerations. Inventions I-IV are drawn to in vivo methods of treatment whereas Invention V is drawn to ex vivo therapy method. Inventions I-IV are classified differently from Invention V. It would require undue burden to search any of Inventions I-IV together with Invention V.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Claim 39 is drawn to missense mutations at multiple codons as follows:

- A) codon 857
- B) codon 1041
- C) codon 1044
- D) codon 1049

Claim 40 is drawn to the following missense mutation:

E) codon 1114

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 37-40 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because inventions I-VI require different searches that are not coextensive,

Art Unit: 1632

examination of these claims would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Valarie Bertoglio whose telephone number is (571) 272-0725. The examiner can normally be reached on Mon-Thurs 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1632

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Valarie Bertoglio', with a long horizontal flourish extending to the right.

Valarie Bertoglio
Examiner
Art Unit 1632